



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,748	11/23/2001	Jeffery M. Enright	D-1112 R4	7030
28995	7590	10/19/2006	EXAMINER POINVIL, FRANTZY	
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			ART UNIT 3692	PAPER NUMBER

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,748

Applicant(s)

ENRIGHT, JEFFERY M.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed 7/20/2006 have been fully considered but they are not persuasive.

Applicant's representative argues that Stinson et al. fail to teach or suggest receiving from a user an input that indicates user agreement for the user's image data to be the user's electronic signature or a user agreement for the user's electronic signature to comprise user input data or a user agreement for the user's electronic signature to comprise user input data or correlating the user image data (as the user's electronic signature) with the document.

In response, the system of Stinson et al requires a user to endorse a check or document and the user to have his facial image be taken before cashing a check or before processing of the legal document. Applicant is directed to the abstract of Stinson et al. Furthermore, on column 1, line 66 to column 2, lines 3-40 and column 7, line 45 to column 8, line 50 it is stated that:

"Next, the ATM 350 prompts the customer to endorse the check and to insert the check into the check reader 130 (step 622), and the customer inserts the check (step 625). The check processing module 315 of the ATM 350 scans the check to produce images of the front and back of the check, validates the MICR ("magnetic ink character recognition") code on the check, and reads designated zones of the check (step 630). If the customer has failed to endorse the check, as indicated by the image of the back of the check, or has inserted the check incorrectly (step 632), then the ATM returns the check to the customer and prompts the customer to endorse the check (if necessary) and to reinsert the check (step 634). If the check has been endorsed and properly inserted, the ATM 350 then displays an image of the front of the check to the customer (step 635) and validates the contents of the check using optical

character recognition ("OCR") (step 640). Using the recognized amount of the check, the ATM then calculates the difference, if any, between the recognized amount of the check and the amount entered by the customer (step 645).".

"Referring to FIG. 7, upon receiving and validating the information from the ATM 350 (step 705), the processor 300 attempts to identify the customer (step 710). To this end, the processor uses identification software that identifies a person based on an image of the person's face.".

"Referring to FIG. 6B, upon receiving the fee and payback amount (step 660), since the check has not been rejected (step 665), the ATM 350 displays the fee and payback amount for verification by the customer (step 667). The ATM 350 then sends a transaction request message to the processor 300 (step 669). Based on the customer's response, the transaction request message indicates to the processor that the transaction should either be continued or cancelled. If the customer has not accepted the transaction (step 671), the ATM 350 returns the customer's check (step 673). The ATM 350 then ends the transaction (step 675) and waits for another customer (step 605). If the customer has accepted the transaction (step 671), the ATM 350 waits for a transaction reply message from the processor 300.".

Thus, Stinson et al clearly teach that a user endorses a check, the user's facial picture or image is taken and compared with the user's stored identification data. The check or legal document is processed as the user's check is cashed and funds are provided to the user upon a positive confirmation and verification of the user's inputted information. Thus, since these information are provided by the user because such is required by the system of Stinson, it is then inherent that the user has/had agreed to these requirements such as the machine or ATM system of Stinson et al asked the user that the user shall agree that at least one imaged portion of the user shall constitute an

electronic signature of the user for purposes of signing the document or the use has agreed for the user's electronic signature to comprise the user's electronic signature or for the user's image data to be the user's electronic signature. If not the check or legal document would not have been processed because the user would not meet the business rules or requirements set forth in Stinson et al.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Stinson et al. (US Patent No. 6,149,056).

As per claims 1, 17, 26-28 and 36-39, Stinson et al disclose a system and method for providing an automatic check cashing system using biometric verification means. The system and method comprise

(a) providing in an automated banking machine a document requiring a signature to achieve a legal effect (see the abstract);

(b) receiving at least one input from a user of the machine indicative that the

user agrees that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user and acquiring the data corresponding to at least one image of the user through operation of the machine. See the abstract, column 7, line 30 to column 8, line 50 and column 9, line 35 to column 12, line 40.

The system of Stinson et al further includes at least one input device on the machine, at least one image acquisition device and at least one controller in operation with the data store. See columns 5-7 of Stinson et al. Stinson et al further teach a marking device operative to apply to the document indicia corresponding to the at least one image.

As per claims 2-8, 20 and 31-34, Stinson et al disclose applying indicia or machine readable indicia from the user or signature of the user corresponding to the at least one image of the document or check wherein the indicia comprises a visual representation of at least a portion of the user, a visual representation of the user's face an image of the user's face, an image of a fingerprint of the user and an image of an iris of the user. See column 8, lines 11-44.

As per claim 9, Stinson et al disclose producing an electronic representation of at least one portion of the document with an imaging device in the system. See column 3, line 65 to column 4, line 4.

As per claims 10-11, 21-23 and 29-30, Stinson et al disclose storing in at least one data store, the electronic representation of the at least one portion of the document in correlated relation with the data corresponding to the at least one image of the user and data corresponding to the at least one input in correlated relation with the data

corresponding to the at least one image. See column 8, lines 11-50 and column 9, lines 35-64 and column 11, line 60 to column 12, line 39.

As per claim 12, Stinson et al disclose delivering the document from the machine to the user if the user does not endorse the check or document. See column 7, lines 55-65.

As per claim 13, Stinson et al disclose that the ATM machines can be used as a stand alone unit thereby being able to store the document therein. See column 5, lines 43-63.

As per claim 14 Stinson et al disclose the document comprises a negotiable instrument such as cash delivered by the user to the machine.

As per claims 15 and 18, Stinson et al disclose the user provides at least one input to the machine indicating that the data corresponding to the at least one image shall constitute endorsement of the negotiable instrument. See the abstract and column 7, lines 55-65.

As per claim 16, Stinson et al disclose applying indicia corresponding to the at least one image to the document responsive to the at least one input. See columns 7-9 of Stinson et al.

As per claim 19, Stinson et al disclose that a check is received in the machine from the user. See columns 7-8.

As per claims 24-25, Stinson et al disclose the at least one image is acquired through operation of a camera or a biometric reading device. See column 8, lines 11-44.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

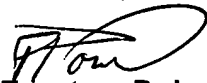
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frantzy Poinvil
Primary Examiner
Art Unit 3692

FP
October 9, 2006